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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,211	01/22/2007	Wilfried Lubisch	ABB10010P0912US	5690
32116 7590 05/08/2008 WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661				
EXAMINER CHANDRAKUMAR, NIZAL S				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
05/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/574,211

**Applicant(s)**

LUBISCH ET AL.

**Examiner**

NIZAL S. CHANDRAKUMAR

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11, 13-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### DETAILED ACTION

This application is a 371 of PCT/EP04/10940 09/30/2004.

Claims 1-12, 13-31 are before the Examiner and subject to the following:

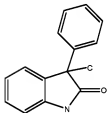
### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

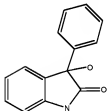
This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-10, 18, drawn to compounds of the core structure.

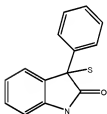


Group 2, claim(s) 1-10, 18, drawn to compounds of the core structure.

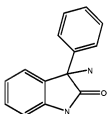


Group 3, claim(s) 1-10, 18, drawn to compounds of the core structure.

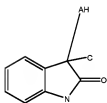
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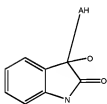
Group 4, claim(s) 1-10, 18, drawn to compounds of the core structure.



Group 5, claim(s) 1-10, 18, drawn to compounds of the core structure.

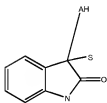


wherein AH is aromatic heteromonocyclic



wherein AH is aromatic heteromonocyclic

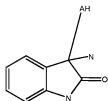
Group 6, claim(s) 1-10, 18, drawn to compounds of the core structure.



wherein AH is aromatic heteromonocyclic

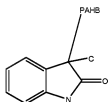
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Group 7, claim(s) 1-10, 18, drawn to compounds of the core structure.



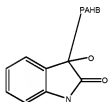
wherein AH is aromatic heteromonocyclic

Group 8, claim(s) 1-10, 18, drawn to compounds of the core structure.



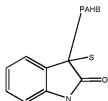
wherein PAHB is partially aromatic heterocyclic

Group 9, claim(s) 1-10, 18, drawn to compounds of the core structure.



wherein PAHB is partially aromatic heterocyclic

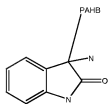
Group 11, claim(s) 1-10, 18, drawn to compounds of the core structure.



wherein PAHB is partially aromatic heterocyclic

Group 12, claim(s) 1-10, 18, drawn to compounds of the core structure.

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wherein PAHB is partially aromatic heterocyclic

Group 13, claim(s) 1-10, 18, drawn to compounds other than those included in Groups 1-12.

Group 14, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 1.

Group 15, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 2.

Group 16, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 3.

Group 17, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 4.

Group 18, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 5.

Group 19, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 6.

Group 20, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 7.

Group 21, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 8.

Group 22, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 9.

Group 23, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 10.

Group 24, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 11.

Group 25, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 12.

Group 26, claim(s) 11, 13-17, 19-31, drawn to methods of treating diseases using compounds of Group 13.

The inventions listed as Groups 1-26 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for

the following reasons: the common technical feature in all groups is the indolone ring system. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art compound SSR 149415 (applicant cited).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required; because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

It is suggested that election of species is included to facilitate prosecution. Applicant is reminded of potential rejections under 35 U.S.C.101 and 35 U.S.C.112: Example:

The point of attachment of heterocyclic moiety to the core structure should be defined. Thus if



is elected as PAHB, to avoid rejection under 35 U.S.C.112 (second paragraph), clear statements with regards to which of the available positions of this PAHB is linked to the indolone fragment is required, commensurate with enabling disclosure with respect to making AND using of such compounds.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nizal S. Chandrakumar whose telephone number is 571-272-6202. The examiner can normally be reached on 8.30 am - 5 pm Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Anders, 571-272-0867 or Primary Examiner D. Margaret Seaman can be reached at 571-272-0694. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative



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or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nizal S. Chandrakumar

/D. Margaret Seaman/

Primary Examiner, Art Unit 1625